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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,675	06/24/2003	Cory Bernu	C62.2-10646-US02	8028

490 7590 06/23/2004

VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA, MN 55343-9185

EXAMINER

YAO, SAMCHUAN CUA

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/607,675	Applicant(s) BERNU, CORY	
	Examiner Sam Chuan C. Yao	Art Unit 1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 8-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>06-21,09-21-03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-7, drawn to a method of binding leaves or other organic debris, classified in class 156, subclass 296.
 - II. Claims 8-20, drawn to an adhesive composition, classified in class , subclass.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process of using that product such as using the recited adhesive composition for bonding papers together or binding books.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. Walter Steinkraus on 02-12-04 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-7. Affirmation of this election must be made by applicant in replying to this

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Office action. Claims 8-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2 and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over White, II et al (US 2001/0032414 A1) in view of Lydzinski et al (US 6,280,514 B1).

White, II et al, drawn to a process of bonding organic debris such as leaves, substantially discloses the process recited in claims 1, 4 and 6-7. White, II et al differs from these claims in that, White, II et al does not teach incorporating an anti-slip additive such as a crushed limestone (i.e. particulate calcium carbonate). However, it would have been obvious in the art to substitute a polysaccharide water-based adhesive taught by White, II et al with an aqueous polysaccharide foamable adhesive suggested by Lydzinski et al, because Lydzinski et al discloses the advantages of using a foamable adhesive (col. 1 lines 12-24); and suggests forming a stable foamable aqueous adhesive comprising a polysaccharide (e.g. starch derivatives, cellulose materials, gum, etc.) and a calcium carbonate filler, wherein the adhesive is suitable for many types of bonding applications (col. 2 line 3-45; col. 3 lines 20-28; col. 4 lines 20-26). It directly follows that, in view of the similarity of the production processes,

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an adhesive (taught by Lydzinski et al) having a filler such as calcium carbonate particles applied in a process taught by White, II et al is reasonably expected to have an anti-slip characteristic. It is worth-noting that, Lydzinski et al also teaches using wood particles as a filling material (col. 3 line 25).

Note further: Where ... the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. **Whether the rejection is based on "inherency" under 35 USC § 102, on prima facie obviousness" under 35 USC § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products."** In re Best, 562 F2d 1252, 1255, 195 USPQ 430, 433-4 (CCPA 1977).

With respect to claim 2, absent any showing of unexpected benefit, one in the art would have determined, by routine experimentation, a workable size and amount of filling material for the desired end-use of an aqueous adhesive.

With respect to claim 5, see column 2 lines 46-50 and column 3 lines 26-29.

7. Claims 1-2 and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over White, II et al (US 2001/0032414 A1) in view of Miyake et al (US 4,374,217).

White, II et al, drawn to a process of bonding organic debris such as leaves, substantially discloses the process recited in claims 1, 4 and 6-7. White, II et al differs from these claims in that, White, II et al does not teach incorporating an anti-slip additive such as a crushed limestone (i.e. particulate calcium carbonate). However, it would have been obvious in the art to incorporate a filling material such as a calcium carbonate to a starch based adhesive taught by White, II et al, because it is a common practice in the art to incorporate a filler

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material such as a calcium carbonate to a starch based adhesive as exemplified in the teachings of Miyake et al (abstract; column 4 lines 51-68; column 5 lines 40-44). It is worth-noting that, Miyake et al discloses adding a filler such as a calcium carbonate to a starch-based adhesive in order to prevent an adhesive from shrinking as the adhesive cures (col. 4 lines 57-68). It directly follows that, in view of the similarity of the production processes, an adhesive (taught by White, II et al) having a filler such as calcium carbonate particles is reasonably expected to have an anti-slip characteristic.

With respect to claims 2 and 5, these claims are obvious in the art for essentially the same reasons set forth above. Note: Miyake et al teaches using about 1-100% by weight based on an amount of starch in the adhesive (col. 4 lines 57-68).

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references set forth in numbered paragraph 6 or 7 as applied to claim 2 above, and further in view of Aydin et al (US 5,100,948).


Since it is old in the art to form an aqueous based adhesive having a filler such as calcium carbonate particles having a dimension of up to 200 microns as exemplified in the teachings of Aydin et al (col. 3 line 55 to col. 4 line 5; claims 1 and 8), it would have been obvious in the art to form an aqueous adhesive taught by Lydzinski et al which has a calcium carbonate filler with a dimensional range of up to 200 microns.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Chuan C. Yao whose telephone number is (571) 272-1224. The examiner can normally be reached on Monday-Friday with second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sam Chuan C. Yao
Primary Examiner
Art Unit 1733

Scy
06-21-04